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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,448	08/28/2001	Dorothea Kuettner	HP-10010890	6373

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EXAMINER

RUHL, DENNIS WILLIAM

ART UNIT PAPER NUMBER

3629

DATE MAILED: 01/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/941,448	KUETTNER ET AL.	
	Examiner	Art Unit	
	Dennis Ruhl	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 16-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 16-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Applicant's election without traverse of claims 1-10,16-20 in the reply filed on 11/2/05 is acknowledged. Applicant has canceled claims 11-15; therefore, claims 1-10,16-20 are currently pending.

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

With respect to claims 1-10, applicant has claimed a data source and various modules that perform various functions, or the means language for claims 6-10. In the specification on page 8, applicant has stated that the modules may be computer programming or may "include human participation" in performing the functions. Based on this disclosure, the examiner has concluded that the claims are directed to non-statutory subject matter because the claimed "data source" can be a human and the modules recited in the claims include humans as well. Because the specification discloses that the modules may include humans to perform the steps, the recited modules (or means limitations) then include humans in their scope, which renders the claims as non-statutory.

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3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 2,7, are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

For claims 2,7,17, applicant has claimed various modules that perform various functions, such as a module to generate financial data and a module to plan and maintain the financial data. Also claimed is a module that determines service and support resources. The examiner has consulted the specification for guidance on how one of skill in the art would go about performing these functions and finds that there is very little guidance on how this is done. What is the financial data that is recited in this claim and how exactly is it generated? With respect to the module to plan and maintain the data, what is there to plan and how is the data maintained? It is not clear at all as to how this is done. The fifth module somehow determines service and support resources, but upon reading the specification, one of skill in the art would not know how this determination is performed. The examiner feels that applicant has more or less set forth some basic concepts of what is to be done, but there is not enough guidance in the specification to allow one of skill in the art to practice the invention as claimed. What factors are taken into account for each module and how are the results

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accomplished? How does the third module generate financial data and what exactly is the financial data, additionally, how is this data “maintained and planned”? It is not clear what this means or how this is accomplished. The determination of serve and support resources is done how? Once you obtain some data on the predicted failures of products and the timing of the failures, how does this system figure out what resources are needed? Not much at all is disclosed with respect to this module. Overall the examiner feels that one of skill in the art would have to practice undue experimentation to figure out how to set up each module so that the recited results can be obtained. The claim is not enabled.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 2,3,5,6,7,17, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claims 2,7,17, it is not clear as to what is meant by “a fourth module adapted to *plan and maintain* said financial data” or “means for *planning and maintaining*”. How is the data “planned”? The examiner is not clear as to how you plan data that was just created. What does this mean? What is meant by “to maintain” the data? Is this supposed to be the act of allowing it's continued storage in a storage medium? Maintained in what sense? This limitation is not clear.

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For claim 3, there is no antecedent basis for "said warranty finance module". What is this module and where has it previously been recited? It is not clear as to what this refers to.

For claim 5, there is no antecedent basis for "said warranty data" as none has previously been claimed. What does this refer to?

For claims 6,7, there is no antecedent basis for "said time dependent warranty event prediction data". It is not clear as to what this is. Does the claim even require that a prediction even be made? This is not clear.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-10,16-20, are rejected under 35 U.S.C. 102(e) as being anticipated by Aragones et al. (6832205).

Aragones discloses a system and method by which product failure data is analyzed with respect to "service contracts" (i.e. warranties) so that the costs associated with the products and the contracts can be analyzed and the results obtained will allow one to forecast future events related to the servicing of the product and what resources may be needed in the future.

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For claims 1,6,16,18-20, Aragones discloses a data source 30 that contains raw data as claimed. The 1st and 2nd modules are interpreted to be portions (subroutines) of the analyzer 34 that performs the recited functions. See column 2, lines 10-14 and figure 3. For claim 6, the means for receiving data is the data bus 16 or other data input hardware of Aragones. This allows data to be received. The means for generating failure data and cost data is analyzer 34 that performs the recited functions.

For claims 2,7,17, as best understood by the examiner, the 3rd and 4th modules are considered to be portions (subroutines) of the simulator 44 that performs the recited functions. The 5th module is satisfied by what is disclosed in column 6, lines 49-57, where the service and support resources are disclosed as being determined. The means for analyzing a change based on alternative data is the analyzer 34. All one has to do is enter new data and see what results the analyzer comes up with. The means for analyzing is the ability to enter new data, which Aragones inherently has.

For claims 3,8, as best understood by the examiner, Aragones inherently is configured to monitor cost data and the resulting data that is output will itself indicate whether or not it is above some threshold value. Aragones is analyzing the same kind of data to determine predicted failures and the servicing costs associated with those failures and this satisfies what has been claimed.

For claims 4,5,9,10, these claims are directed to non-functional descriptive material. The data that the system is intended to use does not constitute a part of the system and reciting the kind of data that the system uses is not a further

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recitation to any further structure. However, Aragonés discloses that data such as claimed is taken into account in the analysis of product failure and the associated "service contract" costs.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DENNIS RUHL
PRIMARY EXAMINER